IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Cunningham et al.**

Serial No.: **10/098,700**

Filed: **March 15, 2002**

For: **Method of Delivering Goods and Services Via Media Related Applications**

Docket No: **4000-007**

PATENT PENDING

Examiner: Russell S. Glass

Group Art Unit: 3626

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August 23, 2010 — Date

Kathy L. McDermott

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REQUEST FOR RECONSIDERATION

The Board is respectfully requested to reconsider its decision of June 21, 2010 affirming the double patenting rejection of the Examiner. In particular, Applicant respectfully urges that the Board utilized an improper approach for determining non-statutory double patenting. It appears that the Board utilized a traditional obviousness analysis when the case law calls for determining if the claims on appeal are an obvious variation of the patented claims.

In particular, the Board found and concluded as follows:

> The '449 patent is concerned with the management of pharmaceutical products issued to consumers (FF 05). Deaton is also concerned with the management of products, in the form of coupons and incentives, that are marketed to consumers (FF 02).

> Deaton addresses this concern by providing a system that utilizes a customer's current and historical purchase history to determine what type of coupon and varying the value of that coupon to be issued to the customer (FF 04). As such, a person with ordinary skill in the art would have recognized combining Deaton with the '449 patent in order to manage products and the value of products issued to customers. Therefore, the '449 patent and Deaton are concerned with the same problem and a person with ordinary skill in the art would have been lead to combine their teachings. (emphasis added)

The Board's Decision, pp. 11-12.

This appears to be a traditional obviousness analysis. After discussing a few of the fact findings (FF 02, 04 and 05) the Board concludes "a person of ordinary skill in the art would have recognized combining Deaton with the '449 patent in order to manage products and the value of products issued to customers" (emphasis added). The Board's Decision, p. 11. Here the Board appears to be combining Deaton with the '449 patent. That is improper. Again, the question is not whether it would be obvious to combine the teachings of Deaton with the '449 patent, but the focus should be on claim 1 of the '449 patent and whether the present claims are a simple variant of the subject matter of claim 1 of the '449 patent. Therefore, it is respectfully urged that the analysis of the Board is incorrect.

It is acknowledged that the determination of an obviousness-type double patenting is close to a determination of obviousness under Section 103. However, the Federal Circuit in *Geneva Pharmaceuticals, Inc. v. Glaxosmithkline PLC*, 349 F.3d 1373, 1378 (Fed. Cir. 2003) explains the differences between a traditional obviousness analysis and an analysis for obviousness-type double patenting. The Federal Circuit points out that obviousness compares the claimed

subject matter to the prior art while non-statutory double patenting compares claims in an earlier patent to claims in a later patent application. Further, obviousness under Section 103 requires inquiry into a motivation to modify the prior art whereas non-statutory double patenting does not. The Federal Circuit went on to state that the non-statutory double patenting "doctrine prevents an applicant from extending patent protection for an invention beyond the statutory term by claiming a slight variant." *Id.* Thus, it appears that the Board used a conventional obviousness analysis. The Board found that a person of ordinary skill in the art would combine Deaton with the '449 patent and arrive at the present claimed invention. Respectfully that is error. The focus must be on one claim of the '449 patent and a determination if the presently pending claims claim a slight variant.

The presently pending claims are not a slight variant of claim 1 or any other claim of the '449 patent. Claim 1 of the '449 patent is directed to a method of distributing, tracking and managing a pharmaceutical trial product. The presently pending claims, on the other hand, have nothing to do with distributing a pharmaceutical trial product, tracking a pharmaceutical trial product, or managing a pharmaceutical trial product. Claim 1 of the '449 patent discloses giving a patient a trial card that entitles the patient to present the trial card to a pharmacy and receive a pharmaceutical trial product. Once the patient presents the trial card to the pharmacy, the pharmacy gives the patient the pharmaceutical trial product identified by the card.

Claim 1 of the '449 patent has nothing to do with varying the value of the trial card. Indeed, the pharmaceutical trial product is free. Claim 1 is clear that simply presenting the trial card to the pharmacy results in the pharmacy giving the patient the pharmaceutical trial product identified by the card. There is no reason for the pharmaceutical trial card to have a variable value that varies according to selected conditions. Indeed, varying the value of the pharmaceutical trial card and requiring the patient to pay for the pharmaceutical trial product would run counter to the pharmaceutical trial program described by claim 1.

As express in *Geneva*, the test is whether claim 15, for example, is a slight variant of the method described in claim 1 of the '449 patent. It is not. The fact that the trial card in claim 1 of the '449 patent is free and never changes in value means that varying the value of a card according to selected conditions can never be a slight or even significant variation from the method described in claim 1 of the '449 patent. The claims on appeal are patentably distinct from claim 1 of the '449 patent. For this reason alone, the Board is respectfully urged to reconsider its decision affirming the Examiner's obviousness-type double patenting rejection.

It is also respectfully urged that the Board has incorrectly construed the term "varying the value of at least some of the media such that the value of the media varies according to selected conditions." This argument is in addition to the argument advanced above and is not essential for reversing the Examiner's obviousness-type double patenting rejection. The question presented here is

whether this claim term requires the media to be issued and thereafter be subjected to variations in value. It is respectfully urged that such is the proper construction of the claim term as a whole. In Deaton, once a coupon is issued its value never varies. The variation occurs before the coupon or media is issued. That is, based on past historical data concerning a customer for example, the coupon will be issued with a value. That issued value never changes. In the claims, the variable value occurs after the media has been issued. The plain language of the claim calls for "varying the value of at least some of the media". As discussed before the entire specification discussing this part of claim 1 refers to varying the value of the actual media issued. Determining a variable value and then issuing the media such that it reflects the determined value is not encompassed by the claims of the present application. That is not varying the value of the media, but is varying the value assigned to the media.

Applicant appreciates that the Board can give a claim term its broadest reasonable construction. However, there is an important caveat to that rule of law. The construction must be consistent with the specification and how a person of ordinary skill in the art would construe the term. Clearly, the specification is directed at varying the value of the media itself and not determining a value from a group of possible values and issuing the media such that it includes the determined value. There is a huge difference between the two constructions.

Further, one of ordinary skill in the art would not modify and convert the product trial card of claim 1 of the '449 patent into a variable value coupon. That

constitutes much more than a slight variation in the method described in claim 1 of the '449 patent. The suggested modification requires changing the product trial card that provides a free pharmaceutical sample to a coupon that has a variable value. Thus, the suggested modification likely requires the patient to pay some portion of the cost of the pharmaceutical sample, albeit at a discount. However, under the suggested modification, the patient would no longer get the same pharmaceutical product for free. This modification likely prevents the method described in claim 1 of the '449 patent from achieving its purpose.

For the reasons set forth above, the Board is respectfully urged to reconsider its decision and to reverse the Examiner's obviousness-type double patenting rejection.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

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Larry L. Coats
Registration No.: 25,620

1400 Crescent Green, Suite 300
Cary, NC 27518

Telephone: (919) 854-1844
Facsimile: (919) 854-2084